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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/672,169 | 09/26/2003 | Adam Tartar Richardson | 0-02-141.01 | 8100 |

7590 06/10/2005

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EXAMINER

NGUYEN, DINH Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3752

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,169

Applicant(s)

RICHARDSON ET AL.

Examiner

Dinh Q. Nguyen

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7, 11-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7, 11-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. After a more thorough examination, the allowance of claims 2-5, 7, 11-13, 15-20 is regretfully withdrawn in light of new references and copending application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2-5, 7, 15-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 14-20 of copending Application No. 10/286,590. Although the conflicting claims are not identical, they are not patentably distinct from each other because of common subject matter, as follows: amended claim 2 of the instant application cites a method of suppressing fire comprising the steps of generating a first fire suppressing gas mixture from at least one non-azide solid propellant chemical, the first fire suppressing gas mixture comprising at least a first gas, said first gas comprising nitrogen; and delivering at least said first gas into the space filtering at least a percentage of a second gas from the first fire suppressing gas mixture prior to delivery into the space, which are fully disclosed in claims 1 and 2 of the '590 application. Similarly,

amended claim 15 of the instant application cites a gas generator that is fully disclosed in claims 14 and 15 of the '590 application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 11-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 14-20 of copending Application No. 10/286,590 in view of Galbraith et al.

Claims 1-8, 14-20 of copending Application No. 10/286,590 teach all the limitations of the claims except for a sensor for detecting a fire. However, Galbraith et al discloses a solid gas generator 14 with a pyrotechnic device 32, and a sensor 30 for suppressing a fire (see figure 1). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the '590 device with a sensor for detecting a fire as suggested by Galbraith et al. Doing so would provide an effective fire suppressing device (see Galbraith column 2, lines 55+).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2, 4, 5, 7, 11-13, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Holland et al.

Holland et al. discloses an apparatus for suppressing fires comprising: a sensor 9 (column 6, line 7 cites means for detecting a fire), solid inert gas generator 32, a diffuser 46, filter 40 to filter a portion of one of the gas (see column 7, line 12+, reduce gases potentially for global warming such as carbon dioxide), or to reduce temperature of the fire suppressing gas mixture (see column 6, lines 54 to column 7, lines 1+).

With respect to claims 2, 4, 5, and 7, the apparatus shown by Holland et al is capable of performing the method or steps recited in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 16, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland et al. in view of Hock.

Holland et al. teaches all the limitations of the claims except for a screen filter. However, Hock discloses a solid gas generator with a screen filter 82 to cool the mixing gases (see Hock's column 8, lines 66 – column 9, line 8), a perforated diffuser cap 30. Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Holland et al with a screen filter as suggested by Hock. Doing so would provide a better device for human consumption.

With respect to claims 17, and 20, to have the 90° or 180° direction cap is an obvious matter of design choice to a person of ordinary skill in the art.

Response to Arguments

9. Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive.

10. Applicant's arguments with respect to claims 2-5, 7, 11-13, 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh Q. Nguyen whose telephone number is 571-272-4907. The examiner can normally be reached on Monday-Thursday 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on 571-272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dinh Q. Nguyen
Primary Examiner
Art Unit 3752